

## **REMARKS**

The above-referenced patent application has been reviewed in light of the Office Action referenced above. Reconsideration of the above-referenced patent application in view of the following remarks is respectfully requested.

Claims 1-24 are pending in the application. Claims 4, 5, 7, 8, 16, 17, 19, and 20 have been cancelled. Assignee submits that cancellation of subject matter above is without prejudice as the same or similar subject matter is intended to be pursued in a Continuation Application based on the present application.

Claims 1, 13-15, 18, and 21-24 have been amended. Claims 25-36 have been added. The amendment is fully supported by the original disclosure. No new matter has been introduced. The above amendments were, in many instances, made to clarify Assignee's claims and do not narrow the scope of the amended claims. In light of this, Assignee asserts that no prosecution history estoppel should result from the above amendments, in many instances.

## **Proper correspondence address**

On September 16, 2005, Applicant filed a Power of Attorney with the Patent Office. Although this document appears in the image file wrapper on PAIR, the last two Office Actions were mailed to the previous firm. Please update your records to ensure that all future correspondence is mailed to Berkeley Law and Technology Group at the address shown on the Power of Attorney form.

## **The rejection of claims 1, 2, 13, and 14 under 35 U.S.C. 102**

Claims 1, 2, 13, and 14 were rejected under 35 U.S.C. §102(b) as being anticipated by US Patent No. 5,633,461 (hereinafter "Kakizaki"). These rejections are respectfully traversed.

Assignee respectfully submits that Kakizaki does not disclose all of the elements of independent claim 1. The Examiner is kindly reminded that the Examiner's initial burden of factually supporting any conclusion of anticipation includes that:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. (See MPEP § 2131.01.)

For example, Examiner has not established that Kakizaki discloses "*a supporting surface capable of contacting the platform of a scanner*", as recited in claim 1. In the Office Action the Examiner has asserted that:

Kakizaki discloses a case body (18) for a **platform (16)** comprising: a housing (18) having an opening on which the platform is placed, and one or more **support elements(17)** mounted on interior walls of the housing, at least one of the support elements comprising: a supporting surface (19, figure 6,7) on a top of each support element configured to contact the platform; and an absorbing body (17a or 17b) located beneath the supporting surface configured to share a stress received by the supporting surface in response to an external force; wherein the support element is located along a periphery of the platform. (See page 2 of the Office Action, emphasis added.)

Assignee cannot agree. Specifically, the Examiner has provided no support from Kakizaki anticipating "*a supporting surface capable of contacting the platform of a scanner*", as is claimed. Conversely, in column 5, lines 29-34 of Kakizaki item 16 is described as a "**printed circuit board 16**"; accordingly, Assignee submits that the Examiner has not established that the item 17 of Kakizaki is "*capable of contacting the platform of a scanner*" as claimed. In the Examiner's Response to Arguments of the present office action, the Examiner counters that:

Applicant's recitation to a scanner platform throughout the claims is a recitation of intended use. A recitation of **intended use** of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the claimed structure is capable of performing the intended use, then it meets the claim. It is the examiner's assertion that Kakizaki's absorber which supports a platform of the circuit board type is also capable of supporting a platform of the scanner.

In regards to applicant's argument that examiner has not point to a disclosure in Kakazaki that the supporting surface is capable of contacting a platform of the scanner, it has been held that **the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform**. It does not constitute a

limitation in nay patentable sense. *In re Hutchison*, 69 USPQ 138. One of ordinary skill in the art would have understood that Kakazaki's shock absorber has the ability to support a platform such as a scanner platform. Such does not necessarily have to be specifically disclosed in Kakazaki. The ability to perform would have been understood by one of ordinary skill in the art. (See pages 3-4 of the Office Action, emphasis added.)

Assignee cannot agree. First, Assignee respectfully submits that the recited limitation of “a supporting surface capable of contacting the platform of a scanner” constitutes a **functional limitation**, and not a statement of intended use. The Examiner is kindly reminded that a **functional limitation** cannot be read out of the claims and must be taught by the reference, as stated in the MPEP that:

**A functional limitation must be evaluated and considered, just like any other limitation of the claim**, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. (See MPEP § 2173.05(g), emphasis added.)

Additionally, Assignee respectfully submits that *In re Hutchison* referenced by the Examiner does not undermine this guidance by the MPEP as 1) the court limited the decision in *In re Hutchison* specifically to **article claims**, and did not address apparatus claims as in the present application, and 2) the cases cited for support in the MPEP all postdate *In re Hutchison*, one by as many as 58 years. Second, Assignee respectfully submits that the Examiner has not claimed that the recited limitation of “a supporting surface capable of contacting the platform of a scanner” is **inherently** show by Kakizaki, nor has the Examiner established a case of inherency.

The Examiner is kindly reminded that:

To establish inherency, the **extrinsic evidence** 'must make clear that the missing descriptive matter is **necessarily** present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). (See MPEP § 2112, emphasis added.)

Here, the Examiner has not established that the **functional limitation** of “*a supporting surface capable of contacting the platform of a scanner*” is explicitly disclosed by Kakizaki, nor has the Examiner established any **extrinsic evidence** that the missing descriptive matter is **necessarily** present in Kakizaki, as is required to establish inherency. In the absence of the Examiner pointing to such a disclosure in Kakizaki, Assignee requests that the rejection be withdrawn as the Examiner has failed to establish that Kakizaki discloses the identical invention as is required for anticipation. See MPEP § 2131.

Likewise, claims 2, 13, and 14 distinguish from Kakizaki on at least the same or similar basis as claim 1. Therefore, Assignee respectfully requests that Examiner’s rejection of claims 2, 13, and 14 be withdrawn.

Likewise, new claims 25-36 distinguish from Kakizaki on at least the same or similar basis as claim 1.

**The rejection of claims 1, 2, 11-14, 23, and 24 under 35 U.S.C. 102**

Claims 1, 2, 11-14, 23, and 24 were rejected under 35 U.S.C. §102(b) as being anticipated by Prior Art Figures 1A and 1B of the present application. These rejections are respectfully traversed.

Assignee respectfully submits that Prior Art Figures 1A and 1B do not disclose all of the elements of independent claim 1. The Examiner is kindly reminded that the Examiner’s initial burden of factually supporting any conclusion of anticipation includes that:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. (See MPEP § 2131.01.)

For example, Examiner has not established that Prior Art Figures 1A and 1B disclose “*an absorbing body located beneath the supporting surface capable of absorbing an external stress*”

*received by the supporting surface in response to an external force*”, as recited in claim 1. In the Office Action the Examiner has asserted that:

Prior art figures 1A-1B discloses a case body (102) for a platform (110) of glass or acrylic resin as disclosed in applicant’s specification comprising: a housing (102) having an opening on which the platform is placed, and one or more support elements(112) mounted on interior walls of the housing, at least one of the support elements comprising: a supporting surface (flat horizontal edge of 112) on a top of each support element configured to contact the platform; and an **absorbing body (the lower vertical section of 112 inherently shares the stress or weight received by the supporting surface or the flat horizontal ledge of 112 since it is supporting the ledge) located beneath the supporting surface configured to share a stress received by the supporting surface in response to an external force**; wherein the support element is located along a periphery of the platform. (See pages 2-3 of the Office Action, emphasis added.)

Conversely, the Prior Art Figures 1A and 1B are described in the specification of the present application as follows:

FIG. 1B is a perspective view of the lower housing provided in a conventional scanner apparatus. As shown, each of the block members 112 can be a set of ribs attached on an inner wall of the lower housing 102. **However, the block members 112 are not sufficient to effectively absorb external shocks. Therefore, when an external force is applied on the platform 110, the block members 112 can not absorb the shock.** As a result, the platform 110 will likely be damaged due to stress concentration in the block members 112. (See paragraph [0007] of the specification of the present application, emphasis added)

Accordingly, Assignee submits that the Examiner has not established that Prior Art Figures 1A and 1B anticipate the claimed “absorbing body” that is “*capable of absorbing an external stress received by the supporting surface in response to an external force*”. In the absence of the Examiner pointing to such a disclosure, Assignee requests that the rejection be withdrawn as the Examiner has failed to establish that Prior Art Figures 1A and 1B disclose the identical invention as is required for anticipation. See MPEP § 2131.

Likewise, claims 2, 11-14, 23, and 24 distinguish from Prior Art Figures 1A and 1B on at least the same or similar basis as claim 1. Therefore, Assignee respectfully requests that Examiner’s rejection of claims 2, 11-14, 23, and 24 be withdrawn.

Likewise, new claims 25-36 distinguish from Prior Art Figures 1A and 1B on at least the same or similar basis as claim 1.

**The rejection of claims 3, 6, 9, 10, 15, 18, 21, and 22 under 35 U.S.C. 103**

The Examiner has rejected claims 3, 6, 9, 10, 15, 18, 21, and 22 under 35 USC 103 as being unpatentable over Prior Art Figures 1A and 1B of the present application in view of US Patent No. 5,224,781 (hereinafter “Rohee”). These rejections are respectfully traversed.

In response, Assignee respectfully submits that claims 3, 6, 9, 10, 15, 18, 21, and 22 are not obvious, at least on the same or similar basis as claim 1 as set forth above with respect to the anticipation rejection in view of Prior Art Figures 1A and 1B. The Examiner is kindly reminded that the Examiner’s initial burden of factually supporting any *prima facie* conclusion of obviousness includes that:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (See MPEP § 2143.03.)

Specifically, the Examiner has failed to establish that Prior Art Figures 1A and 1B teach or suggest “*an absorbing body located beneath the supporting surface capable of absorbing an external stress received by the supporting surface in response to an external force*”, as recited in independent claim 1. Additionally, the Examiner has not established that Rohee cures Prior Art Figures 1A and 1B of this failure. In the absence of the Examiner pointing to such a suggestion, Assignee requests that the rejection be withdrawn as the Examiner has failed to establish that the proposed combination renders claims 3, 6, 9, 10, 15, 18, 21, and 22 obvious.

It is noted that claimed subject matter may be patentably distinguished from the cited references for additional reasons; however, the foregoing is believed to be sufficient. Likewise, it is noted that the Assignee’s failure to comment directly upon any of the positions asserted by

the Examiner in the office action does not indicate agreement or acquiescence with those asserted positions.

**Conclusion**

In light of the foregoing, reconsideration and allowance of the claims is hereby earnestly requested.

**Invitation for a Telephone Interview**

The Examiner is invited to call the undersigned attorney, James J. Lynch, at (503) 439-6500 if there remains any issue with allowance.

**Additional fees**

Any fees or extensions of time believed to be due in connection with this amendment are enclosed herein; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-3703.

Respectfully submitted,

Berkeley Law and Technology Group, LLC

Dated: November 2, 2006

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